

### **REMARKS**

As shown in the claim listing above, claims 1-32 are pending in the application, with claims 1, 25, and 32 being independent. This paper amends independent claims 1 and 25 and adds new claims 31 and 32. Reconsideration of presently pending claims 1-32 is respectfully requested in light of the above amendments and the following remarks.

#### **Declaration**

The Office Action objects to the Declaration. Applicants are working to provide the Patent Office with an updated declaration or updated Application Data Sheet identifying the mailing address and residence of inventor Christian Fleury. This will be provided with the next communication.

#### **Compliance with 35 U.S.C. § 102**

The Office Action rejected independent claims 1 and 25 under 35 U.S.C. §102(b) as being anticipated by WO 93/26075 to Dunlop et al. ("Dunlop"). With respect to the claims as herein amended, this rejection is respectfully traversed.

Claim 1 is directed to a handheld surgical instrument. It recites, among other features, the plurality of laminations are separated from each other by an insulator.

Dunlop fails to disclose a surgical instrument having all the features claimed, including a plurality of laminations separated from each other by an insulator. Dunlop discloses an armature core 13 formed of annular laminations. P.4, l. 32. However, there is no disclosure of an insulator separating the laminations. Furthermore, the references applied to support obviousness rejections do not disclose these features. Accordingly, Applicants respectfully request that the rejection be withdrawn and claim 1 passed to allowance.

Claim 25 is directed to an electric motor for use in a surgical procedure. The motor includes “a driving member having ... a magnetically conductive portion ... [that] comprises a plurality of laminations of annealed ribbon-shaped material, wherein the plurality of laminations includes a surface oxide layer as an insulator.” Neither Dunlop nor any of the other applied references disclose a motor having these features. Accordingly, Applicants respectfully request that claim 25 be passed to allowance.

#### Dependent claims

Claims 2-24 and 26-30 depend from independent claims 1 and 25 respectively. Therefore, these claims should be allowable for at least the reasons that the respective independent claims should be allowable. Accordingly, Applicants respectfully request that the Examiner allow these claims.

#### New Claims 31 and 32

Claims 31 and 32 have been added and are deemed to be patentable over the cited art. Claim 31 depends from claim 1 while claim 32 is independent. Applicants respectfully request that the Examiner consider these claims and pass them to allowance.

#### Conclusion

For at least the reasons set forth above, Applicants submit that pending claims 1-32 are in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the outstanding rejections and issue a formal notice of allowance.

The Office Action contains characterizations of the claims and the related art to which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in this or any other Office Action.

US Ser. No. 10/698,114  
Reply to Office Action of 3/27/08

Attorney Docket No.: P11256 / 31849.88  
Customer No.: 46334

A personal or telephonic interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

Respectfully submitted,



Dustin T. Johnson  
Registration No. 47,684

Dated: June 25, 2008

HAYNES AND BOONE, LLP  
Customer No.: 46334  
Telephone: 972/739-6969  
Facsimile: 214/200-0853  
Attny. Docket No.: P11256 / 31849.88

R-196000\_1.DOC

**Certificate of Service**

I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on June 25, 2008.



Diane Sutton